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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,881	02/10/2004	Luc Lemmens	1316N-001663	1429
27572 7590 01/09/2008 HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			EXAMINER SCHWARTZ, CHRISTOPHER P	
			ART UNIT 3683	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/775,881
Filing Date: February 10, 2004
Appellant(s): LEMMENS ET AL.

MAILED

JAN 09 2008

GROUP 3600

Michael J. Schmidt
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 2, 2007 appealing from the Office action mailed May 25, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

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The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

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(6) Grounds of Rejection to be Reviewed on Appeal

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the second fluid passage, as now claimed, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-6 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 1, as previously explained, and looking to the claimed embodiment of figure 4 and the description on page 12 describing the claimed embodiment, the specification never states that when membrane 52b is in the closed or second position that it "*prevents fluid flow through the fluid passage*" (the "passage" being identified as being 130 in the spec and drawings). On the contrary, figure 4 shows via two arrows, the path of fluid flow when the "lower membrane 52b" is in the "closed" position, or is in the seated position on the land. Therefore, applicant's added limitation to claim 1 of "... the second fluid passage is closed to prevent fluid flow through the second fluid passage" is considered to be new matter (and it must be removed from the claim) since it was not described in the specification at page 12, or shown in figure 4, in the claimed manner.

It is unclear where this second fluid passage is in the drawings.

Applicant's amendment to the specification does nothing to clarify the problem outlined above.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vermolen et al. in view of de Molina

Regarding claim 1, subject to the 112 rejection and drawing objection above, Vermolen et al. discloses a container having first and second chambers 36,40, a piston rod 44, a piston 38, a valve 60 separating first and second chambers (102,112-- as per appellant's) a membrane (shim disc) 78 defining an "aperture" 106,108, a pressure

signal supplied from an air spring to the valve (see col 3 lines 37-41), the valve functioning as claimed. The "first passage" is considered to be the flow path from 98, or chamber 102, up between the land 96 and the membrane 108, while the second passage may flow directly through the aperture 106. Note that flow can flow from area 94 through 102 and into chamber 112 as well.

Lacking in Vermolen et al. is a prevention of fluid flow through the restriction 108 around the land when membrane 78 is in it's lower most position. However, Vermolen et al. states in column 5 lines 20+ that the aperture 106 and the thickness of shim disc 78 are "tuning parameters of the shock absorber" and that the "size of the restriction 108 will be controlled by the size of hole 106, the thickness of shim disc 78..." See also lines 62-65. Vermolen et al. shows a relatively sloped membrane relative to the surface of the land, presumably to create the restriction 108.

De Molina et al. shows and describes a similar arrangement in figure 4, but shows a plurality of discs 136.. See the discussion in column 6 lines 34-57. Although it is never stated the flexible discs 136 actually contact the land 160, presumably this could happen with enough "control pressure" applied to chamber 158 to stiffen the damping characteristics of the absorber for a particular application.

To have applied these teachings to Vermolen et al., so that fluid flow is prevented by having shim disc, or discs, 78 contact the land 96 would have been obvious for the purposes of changing the damping characteristics of the device to meet specific damping requirements. Such a modification would not materially effect the original functioning of the device.

Regarding claim 2 note downtube 62. The chambers 36,40 communicate with an outlet at either 92 or 94 to in turn communicate with each other, as broadly claimed.

Regarding claim 3, as broadly claimed, these requirements are met at 78 in figure 3.

Regarding claims 5,6 these requirements are met. Note the discussion in column 3 and the control lines at 32.

Regarding claim 4 simply to have used more than one disk in the area of 78 of Vermolen et al., as taught by de Molina at 136, would have been obvious to the ordinary skilled worker in the art simply to control the level of fluid flow through the valve to a desired level and therefore attain the damping characteristics desired from the suspension system. Note the through-hole at 106.

(10) Response to Argument

With respect to the 112 first paragraph rejection as previously explained, and looking to the claimed embodiment of figure 4 and the description on page 12 describing the claimed embodiment, the specification never states that when membrane 52b is in the closed or second position that it "**prevents** fluid flow through the fluid passage" (the "passage" being identified as being 130 in the spec and drawings). On the contrary, figure 4 shows via two arrows, the path of fluid flow when the "lower membrane 52b" is in the "closed" position, or is in the seated position on the land. Therefore, applicant's added limitation to claim 1 of "... the second fluid passage is closed to prevent fluid flow through the second fluid passage" is considered to be new

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Appellant's state on page 8 of their remarks that as long as there are low flow rates passage 130-- identified at page 12 paragraph [0031] of the specification as being "within" two of the bottom plates 128— is sufficient to allow venting, or the flow of fluid therebetween. Appellant's then argue that this inherently would teach that there would be "no flow" through a second passage (between lower membrane 52b and the land) and that lower membrane "must" inherently prevent this flow.

This examiner disagrees because this was not described in the specification, or shown in figure 4, that this is the case. Applicant's discussed no specifics in their specification about piston speeds, about spring force/spring constant of the disks, or any other physical parameters of the device that would indicate these discs remain in a closed or seated state to prevent fluid flow between the land and the discs, but only during certain times. Further, it is notoriously well known in the art that fluid often seeps between the spring discs and the land -- both of which generally are made of a rigid plastic or metal composite (i.e. since this arrangement exhibits no fluid sealing effect), in similarly structured absorbers.

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De Molina is relied upon to teach that a plurality of such discs 78 may be used and that with enough air pressure applied to them may close off a fluid passage between the land and the discs.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Christopher P. Schwartz

Application/Control Number:
10/775,881
Art Unit: 3683

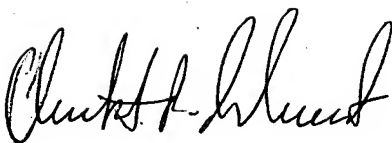
Page 10

Conferees:

Meredith Petravick

Robert Siconolfi

Christopher P. Schwartz

A handwritten signature in cursive script, likely belonging to Christopher P. Schwartz, positioned to the right of his name.



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